

REMARKS

The enclosed is responsive to the Examiner's Office Action mailed on December 19, 2008. At the time the Examiner mailed the Office Action, claims 1-46 were pending. By way of the present response applicant has: 1) amended claims 1-3, 5-13, 19, 32, 36, 40, and 42; 2) added claim 49; and 3) canceled claim 15. As such, claims 1-14, 16-46, and 49 are now pending. Reconsideration of this application as amended is respectfully requested.

Applicant respectfully submits that no new matter has been added. Support for the amendments is found in the specification as originally filed. For example, in reference to the amendments to claims 1, 3, and 7-10, and the addition of new claim 49, applicant notes that the specification recites:

A pressurised fluid supply may be supplied to the void space via a fluid inlet port 12, ducted through the void space 10 (for example, following the flow path indicated by arrows A) by ducting means, and removed via a fluid outlet port 13.

(page 14, lines 12-15), and

In both the first and second aspects of the present invention a controller can be employed to monitor the levels or power supply and/or motor cooling fluid supply to the hand tool. The controller, or control box may be a housing which includes hand tool and motor diagnostic equipment, and provides an indicator (both to a computer monitoring and/or visible indicators) system as to the power supply and cooling fluid supply. The control box can house equipment which ensures that a minimum of cooling fluid (or pneumatic cooling fluid) supply continually reaches the motor when it is in operation, or if this minimum requirement is not met (that is, the pressure and/or flowrate of the cooling fluid through the hand tool is not sufficiently high), the power supply to the hand tool may be suspended (disabled) until the supply is corrected.

(page 16, lines 9-18).

Applicant respectfully submits that the present application discloses a cooling fluid pressure both leaving and returning to the controller – i.e., a first pressure and a second pressure. Furthermore, monitoring the pressure through the hand tool inherently involves monitoring the pressure delivered to and returning from the void space. Accordingly, applicant submits that the claims are supported by the specification as originally filed.

Claim Rejections – 35 U.S.C. §103

Claims 1-4, 14, 16-18, 21, 23-27, 36 and 38-46 stand rejected under 35 U.S.C. §103(a) as being unpatentable over Norman (U.S. Patent No. 6,635,067, hereinafter, “Norman”) in view of Selewski et al., (U.S. Patent No. 6,777,844, hereinafter, “Selewski”).

Norman describes a liquid-cooled, hand-held surgical tool. Selewski describes a vacuum cleaner assembly powered by a brushless motor. In particular, Selewski discloses that the motor assembly is cooled by air flow generated by an axial flow motor fan attached to the upper portion of the motor shaft. (Selewski, col. 4, lines 29-34).

Applicant respectfully submits that Norman does not teach or suggest a combination with Selewski and that Selewski does not teach or suggest a combination with Norman. The combination of the surgical tool described in Norman and a vacuum cleaner’s motor assembly in Selewski is the result of impermissible hindsight based only upon the present application.

Furthermore, even if Norman and Selewski were combined, the combination fails to disclose a controller configured to turn off the motor if the pressure of

gaseous fluid exiting the void space falls below a predetermined level. Applicant agrees with the Office Action's assertion that Normal fails to disclose this feature. However, applicant disagrees with the Office Action's assertion that this feature would have been obvious in view of Selewski. In contrast to this feature of claim 1, Selewski discloses a thermal sensor to detect overheating of the motor and shut down the motor if the temperature exceeds a threshold. (Selewski, col. 9, lines 18-28). Selewski (and thus the combination) is silent in regard to the pressure of gaseous fluid exiting the void space.

The Office Action states, "[t]he flow of coolant on the motor is responsive to detected temperature of the motor; such that the higher temperature, the higher the flow of coolant, the higher the pressure of the coolant." (Office Action dated 12/19/2008, page 3). Applicant respectfully disagrees. Selewski describes a fan to cool the motor, but does not describe that the fan is responsive to detected temperature. Instead, Selewski describes shutting down the motor in response to a detected temperature. Furthermore, the higher the flow of coolant does not necessarily equate to a higher pressure of the coolant.

Additionally, monitoring the pressure of gaseous fluid exiting the void space provides advantages over monitoring the temperature as disclosed in Selewski. Determining the pressure of gaseous fluid exiting the void space allows the user to determine whether any gaseous fluid has been lost during use, e.g., through hose or other leaks. Monitoring the temperature of air flow and subsequently calculating the rate/pressure of the coolant (which is not disclosed by the references, only inferred by the Office Action) would not provide any indication of gaseous fluid escaping from the tool during use. Any loss of gaseous fluid during use in a sterilized

environment can be considered a contaminant. Furthermore, maintaining a particular pressure within the tool can serve to prevent water/liquid ingress into the tool, which can damage the motor -- e.g., when dipping the tool into a sterilization bath. Lastly, when dipping the tool into a sterilization bath that is of a high temperature, the tool is subject to high fluctuations in temperature that do not necessarily correspond to the temperature of the motor. Therefore, it is beneficial to use the pressure rather than temperature to turn off the motor.

Accordingly, applicant respectfully submits that the rejection of claim 1 has been overcome.

Given that claims 2-4, 14, 16-18, 21, 23-27, 36 and 38-46 are dependent upon claim 1, and include additional features, applicant respectfully submits that the rejection of claims 2-4, 14, 16-18, 21, 23-27, 36 and 38-46 has been overcome for at least the same reasons as above.

Claims 5-13 and 29-37 stand rejected under 35 U.S.C. §103(a) as being unpatentable over Norman in view of Selewski and further in view of Sjostrom et al (U.S. Patent No. 5,712,543, hereinafter, "Sjostrom"). Sjostrom describes a magnetic switching element for controlling a surgical device.

Given that claims 5-13 and 29-37 are dependent upon claim 1, and include additional limitations, and given that Sjostrom fails to remedy the shortcomings of Norman and Selewski discussed above, applicant respectfully submits that the rejection of claims 5-13 and 29-37 have been overcome for at least the same reasons as above.

New Claim

Given that new claim 49 is dependent upon claim 1, and includes additional features, applicant respectfully submits that claim 49 is patentable over Norman, Selewski, and Sjostrom for at least the same reasons as above.

CONCLUSION

Applicant respectfully submits that in view of the amendments and arguments set forth herein, the applicable objections and rejections have been overcome.

Applicant reserves all rights under the doctrine of equivalents.

Pursuant to 37 C.F.R. 1.136(a)(3), applicant hereby requests and authorizes the U.S. Patent and Trademark Office to (1) treat any concurrent or future reply that requires a petition for extension of time as incorporating a petition for extension of time for the appropriate length of time and (2) charge all required fees, including extension of time fees and fees under 37 C.F.R. 1.16 and 1.17, to Deposit Account No. 02-2666.

Respectfully submitted,

BLAKELY, SOKOLOFF, TAYLOR & ZAFMAN LLP

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/Ryan W. Elliott/

Ryan W. Elliott
Reg. No. 60,156

1279 Oakmead Parkway
Sunnyvale, CA 94085-4040
(408) 720-8300